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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,986	11/26/2003	Giuseppe Dal Pra'	CAM3-PT037.1	9023

3624 7590 09/22/2004

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UNITED PLAZA, SUITE 1600
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EXAMINER

CHARLES, MARCUS

ART UNIT	PAPER NUMBER
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3682

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/722,986

Applicant(s)

DAL PRA', GIUSEPPE

Examiner

Marcus Charles

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MLW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/994,718.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 02-27-04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This is the first action relating to serial application number 10/722,986, filed 11-26-2003.

Claims 1-21 are currently pending.

Priority

1. Applicant is reminded that in order for a patent issuing on the instant application to obtain the benefit of priority based on priority papers filed in parent Application No. 09/994,718 under 35 U.S.C. 119(a)-(d) or (f), a claim for such foreign priority must be timely made in this application. To satisfy the requirement of 37 CFR 1.55(a)(2) for a certified copy of the foreign application, applicant may simply identify the application containing the certified copy.

Drawings

2. The examiner has accepted the drawing filed with this application as formal drawing.

Specification

3. The disclosure is objected to because of the following informalities: The first paragraph relating to "Cross Reference to Related Applications" must be updated to include US Patent Application No. 09/994,718, has a patent no. 6,685,586.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3, 8, 15-16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP (0413053) in view of JP ('04222865). EP ('461053) discloses a rocker assembly for a rear derailleur comprising an inner and outer plate (2, 3), a pair of idler wheels (1) between the plates and intended to cooperate with a chain of bicycle and the inner plate is made from a metallic material, a wheel (6) mounted on a pin (2b) and a spring connected to the wheel to rotate the wheel about the pin. EP('461053) does not disclose that the outer plate (3) is made structural fiber fabric incorporated in a plastic material matrix. JP ('04222865) discloses a material made of a fiber fabric in combination with a thermoplastic matrix and subjected to compression molding in order to produce a lightweight structure, that is non-easily contaminated due to exposure to undesirable atmospheric elements and to obtain uniform shape and properties throughout the structure. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the outer plate of EP ('461053) so that it is made from fiber fabric in combination with a thermoplastic matrix and subjected to compression molding in view of JP ('04222865) in order to produce a lightweight structure, that is non-easily contaminated due to exposure to undesirable atmospheric elements and obtain uniform shape and properties throughout the structure.

6. Claims 2, 4 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP ('461053) in view of JP ('04222865) as applied to claim 1 above, and further in view of Dietzsch (4,809,843). EP ('461053) in view of JP ('04222865) do not disclose the plastic material is thermosetting and the fabric is carbon base fiber. Dietzsch

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discloses a carrier comprising a thermosetting plastic with carbon base fiber in order to reduce weight and increase strength. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the device of EP ('461053) to include a thermosetting plastic with carbon base fiber in view of Dietzsch in order to reduce weight and increase strength.

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP ('461053) in view of JP ('04222865) as applied to claim 1 above, and further in view of JP ('35-37313). EP ('461053) does not disclose that the pin (3c) is fastened to the outer plate by caulking. JP ('35-37313) a pin (2) is attached to a plate (1) by caulking in order to reduce connection cost and increase strength. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the device of EP ('461053) so that the pin is attached to the outer plate by caulking in view of JP ('35-37313) in order to reduce connection cost and increase strength.

8. Claims 9, 7, 13-14 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP ('461053) in view of Juy (3,910,136). EP ('461053) discloses the claimed invention as in paragraph 5 above, including first and second holes (2a1, 2b1) in the inner plate (2), the outer plate having apertures (3a, 3b) aligned with the holes. EP ('461053) does not disclose the outer plate is made from a plastic composite material and the holes are tapped holes. It is well known in the art that plastic composite materials are lighter and more flexible than metals. Juy disclose a derailleur having an outer plate (12) made from a plastic reinforced material in order to reduce the weight and increase flexibility and outer plate (12) having tapped holes in order to easily

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dismantle and assemble the device. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the outer plate of EP ('461053) so that it is a reinforced plastic composite and the holes are tapped holes in view of Juy in order to reduce the weight, increase flexibility and to easily dismantle and assemble the device.

In addition in claims 7, 13 and 20, EP ('461053) does not disclose the cross-section of outer plate has a shape of a shallow channel. Juy) discloses a derailleur with an outer plate with the cross-section with a shape of a shallow channel in order to improve the strength without increasing thickness. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the outer plate of EP ('461053) so that the cross section has a shape of a shallow channel in view of Juy in order to improve the strength without increasing thickness.

In claim 14, note the apertures in EP (461053) device.

9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP (461053) in view of Juy as applied to claim 9 above, and further in view of JP ('04222865). EP (461053) in view of Juy do not disclose the composite material is composite plastic. JP ('04222865) discloses the claimed invention as in paragraph 5 above. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the outer plate of EP ('461053) so that it is made from fiber fabric in combination with a thermoplastic matrix and subjected to compression molding in view of JP ('04222865) in order to produce a lightweight

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structure, that is non-easily contaminated due to exposure to undesirable atmospheric elements and obtain uniform shape and properties throughout the structure.

10. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP (461053) in view of Juy as applied to claim 9 above, and further in view of JP ('04222865). EP (0461053) and Juy do not disclose the plastic is subjected to compression molding. JP ('04222865) discloses the claimed invention as in paragraph 5 above. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the outer plate of EP ('461053) so that the thermoplastic material is subjected to compression molding in view of JP ('04222865) in order to produce a lightweight structure, that is non-easily contaminated due to exposure to undesirable atmospheric elements and to obtain uniform shape and properties throughout the structure.

11. Claims 12 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP (461053) in view of Juy as applied to claim 9 above, and further in view of Kojima (5,624,336). EP ('461053) does not disclose the metallic material is aluminum alloy. It is well known in the art that aluminum is used for its lightweight composition and aesthetic values. Kojima discloses a derailleur having a guide plate (5) made from aluminum alloy. Therefore, would have been obvious to one of ordinary skill in the art at the time of the invention to modify the metallic plate of EP (461053) so that is aluminum alloy in view of Kojima in order to reduce the weight and increase its aesthetic value. In addition, it has been held to be within the general skill of a worker in the art to select a

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known material on the basis of its suitability for the intended use as a material of obvious design choice. *In re Ileshin*, 125 USPQ 416.

Double Patenting

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claims 1-3 and 5-21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6,685,586. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are obvious variations in breath and scope.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Nagano ('553), WO 9316910) and Ozaki ('366) disclose a rear derailleur with an inner and outer plate and a pair of wheels therebetween. JP ('10-30633) and JP (64-90504) disclose a pin being caulked to a plate. JP (64-90504) discloses a pin and plate connected by caulking. JP (0171583), EP (0414214) and Matsuda et al. (5,316,834) disclose a material comprising a plastic matrix with carbon


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fiber. FR (2539096) discloses a derailleur with a guide plates comprising plastic and fiber composition.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marcus Charles whose telephone number is (703) 305-6877. The examiner can normally be reached on Monday-Thursday 7:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci can be reached on (703) 308-3668. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Marcus Charles
Primary Examiner
Art Unit 3682
September 14, 2004